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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/196,199	11/20/98	FARMWALD	PU43D2C2

NEIL A STEINBERG  
5827 OSCEOLA ROAD  
BETHESDA MD 20816

MM41/0527

EXAMINER  
NGUYEN, T

ART UNIT  
2818

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DATE MAILED: 05/27/99

# 5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/196,199

Applicant(s)

FARMWALD et al.

Examiner

TAN T. NGUYEN

Group Art Unit

2818

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/20/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 151-172 is/are pending in the application.
- Of the above claim(s) 1-150 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 151-167 and 172 is/are rejected.
- ☒ Claim(s) 168-171 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 11/20/98 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The Preliminary Amendment filed by Applicants on November 20, 1998 has been received.
2. The proposed drawing correction filed by Applicants on November 20, 1998 has been approved.
3. The Information Disclosure Statement submitted by Applicants on March 26, 1999 has been received and fully considered.
4. Claims 1-150 have been canceled.

New claims 151-172 have been added.

5. Claims 161, 164-165 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 161, line 2; claim 164, lines 1-2, it is not clear what the "set register request" is.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 151-167 and 172 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 163-165, 167, 170-171, 174

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of copending Application No. 09/196,200 in view of claims 13, 17 of U.S. Patent No. 5,657,481.

Claim 164 of U.S. Patent Application No. 09/196,200 recites a synchronous memory device comprising a programmable register to store a value representative of a delay time after which the memory device responds to a read request, and a plurality of drivers to output data in response to the read request and in accordance with the delay time. Claim 164 does not recite the clock receiver.

Claim 13 of U.S. Patent no. 5,657,481 recites a memory device comprising clock signal receiving circuitry coupled to receive an external clock signal, the clock signal receiving circuitry generating a local (internal) clock signal, an interface circuitry coupled to the memory array wherein data is transferred between the interface circuitry and the memory array. The interface circuitry would be understood as the output drivers.

Regarding claims 152,154 and 158, claim 17 of U.S. Patent No. 5,657,481 recites a delay circuit coupled to a first phase locked loop circuitry which is coupled to a first clock signal receiving circuit.

Regarding claim 155, claim 165 of the U.S. Patent Application No. 09/196,200 recites the value of the delay time is stored in the register after the power is applied to the memory device.

Regarding claims 161 and 164, claim 167 of U.S. Patent Application No. 09.196,200 recites in response to a set register request, the value of a delay time is stored in the register.

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Regarding claims 165 and 166, claims 163 and 170 of U.S. Patent No. 09/196,200 recites the set register request and the time delay value are provided to the memory device in a single request packet.

Regarding claim 167, claim 171 of U.S. Patent No. 09/196,200 recites the step of initializing the register by providing a time delay value to the memory device after issuing a set register request.

Regarding claims 156, 162 and 172, claim 174 of U.S. patent No. 09/196,200 recites a step of selecting one of a plurality of time delays after which the memory device is to provide data in response to a read request.

Regarding claims 153-159, whether the output driver outputs data in response to a rising edge or falling edge of the internal clock signal is an obvious choice design.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the memory device in claim 164 of U.S. Patent Application No. 09/164,200 by providing the clock receiving circuit in claim 13, the phase locked loop and the delay circuit in claim 17 of U.S. Patent No. 5,657,481.

The rationale is as follows: A person of ordinary skill in the art would have been motivated to use the clock circuitries in U.S. Patent No. 5,657,481 to generate internal clock signals which are used to optimize the access operations of the memory device.

This is a provisional obviousness-type double patenting rejection.

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8. Claims 168-171 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan T. Nguyen whose telephone number is (703) 308-1298. The examiner can normally be reached on Monday to Friday from 08:00 AM to 04:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David C. Nelms, can be reached on (703) 308-4910. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Tan T. Nguyen  
Primary Examiner  
Art Unit 2818  
May 20, 1999

T.N  
05/20/99